

REMARKS

I. Status of the Claims

Claims 25, 26, 33-46, 48-52, and 54-56 are currently pending. Applicants have canceled claim 53 without prejudice or disclaimer to the subject matter contained therein.

II. Rejection Under 35 U.S.C. §112, 1st paragraph

The Examiner has rejected claims 53-56 under 35 U.S.C. §112, 1st paragraph as allegedly containing subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the invention.

According to the Examiner, "a wear layer 'having a uniform viscosity that is applied before chemically embossing and cured prior to mechanically embossing' lacks support in the disclosure, as filed." Office Action at 2. While Applicants respectfully disagree, to advance prosecution, Applicants have canceled claim 53, thus obviating this rejection.

In addition, the Examiner believes that the element in claim 54 reciting, "wherein the mechanically embossed portion of the wear layer includes all of the surface of the wear layer, except the chemically embossed portion," lacks support in the specification.

Applicants respectfully disagree with this rejection for at least the following reasons.

In the sentence bridging pages 11-12, the specification expressly teaches that “the portion of the foam layer which has been overlayed with the design layer **having the retarder composition is not mechanically embossed.**” (emphasis added) The portion being referred to is the “chemically embossed” portion, that portion that has had the foaming reaction retarded. Because the specification literally supports a mechanically embossed portion of the wear layer that includes all of the surface of the wear layer, except the chemically embossed portion, claims 54-56 meet the requirements of 35 U.S.C. §112, 1st paragraph. Applicants thus request that this rejection be withdrawn.

III. Rejection Under 35 U.S.C. §103

A. The Examiner has maintained the rejection of claim 53 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 3,978,258 to Faust et al. (Faust). This rejection has been rendered moot by the cancellation of claim 53.

The Examiner correctly notes that there is no rejection of claims 54-56 based on the Faust references. See Office Action at page 3. In fact, these claims are not rejected over any prior art, but only under 35 U.S.C. §112, 1st paragraph. Because Applicants believe that this rejection is improper for the above-stated reasons, claims 54-56 should be in condition for allowance. Applicants respectfully request that the Examiner indicate the allowability of these claims in the next Office Action. For the

following reasons, Applicants also request that the Examiner indicate the allowability of the remaining pending claims.

B. The Examiner has maintained the rejected claims 25, 26, 33-46, 51 and 52 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 4,214,028 to Shortway et al. ("Shortway").

MPEP §2143 mandates that to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. As the prosecution history shows, and as described in more detail below, the Examiner has not met any of these three criteria, and certainly not all three.

The claimed invention is directed to a method of making a surface covering comprising a sequence of steps neither taught nor suggested by the prior art. Indeed, the primary reference, Shortway, at most teaches such steps to occur in the reverse order to that claimed. Thus, Shortway clearly does not teach all the elements of the claimed invention. Furthermore, any modification of the Shortway method to arrive at the claimed invention is improper as it would necessarily teach away from what Shortway is disclosing. For example, unlike embodiments of the claimed invention,

Shortway teaches that the mechanical embossing step is performed prior to the chemical embossing step. The Examiner's attention is specifically directed to well-known Federal Circuit decisions holding that if a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. See, *In re Fritch*, 972 F.2d 1260, 1265-66, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959) (holding a rejection improper under section 103 because it "would require a substantial reconstruction and redesign of the elements shown in [a prior art reference] as well as a change in the basic principles under which [that reference's] construction was designed to operate."). Accordingly, there can be no motivation to modify Shortway to arrive at the claimed invention.

Finally, Shortway does not provide a reasonable expectation of successfully obtaining the claimed invention. Rather, as described in the prosecution history, the order of chemical and mechanical embossing, and the materials response to those steps are of technical and patentable significance. For these reasons, one can objectively conclude that the Examiner's rationale for modifying Shortway is based on an obvious to try theory. However, obvious to try is not the legal standard under 35 U.S.C. 103. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-1681 (Fed. Cir. 1988).

In view of the foregoing, the *prima facie* case of obviousness advanced by the Examiner is improper. Applicants respectfully request that the rejection over Shortway be withdrawn.

C. The Examiner has maintained the rejection of claims 48-50 under 35 U.S.C. §103 as being unpatentable over Shortway, as applied to claims 25, 26, 33-46, 51 and 52 above, and further in view of U.S. Patent No. 4,100,318 to McCann et al. ("McCann"). In addition to the above deficiencies in Shortway, the Examiner's rejection including McCann is further deemed improper because it still stems from a false premise and is based on an improper foundation. According to the Examiner, for example, "the scope of the claims at issue is such that it encompasses use of components which may or may not be affected by the timing of the chemical embossing step." See, e.g., previous Office Action at p. 4. It is clear that in maintaining this rejection, the Examiner is relying on what Applicants are disclosing rather than what they are claiming or what the prior art is teaching.

Contrary to the Examiner's assertion, the prior art components do dictate an order for chemical and mechanical embossing (when both are taught in combination), but the invention claimed in claims 48-50 also recite a particular order for chemical and mechanical embossing. For the reasons previously described, as well as those of record, the difference in order taught by Shortway cannot be remedied by McCann (or

any other secondary reference) because it goes to the heart of the Shortway patent, which describes a particular method based on first mechanically embossing a gelled (pre-cured wear) layer followed by curing and chemical embossing.

It is well-established that it is improper to combine references if their combination would result in the destruction of the intended operation (of the method described in the reference) or if a reference teaches away from the claimed invention. See, *In re Laskowski*, 10 USPQ 2d 1397 (Fed. Cir. 1989). See, also *In re Fritch*, 972 F.2d at 1265-66, 23 U.S.P.Q.2d at 1783; *In re Ratti*, 270 F.2d at 813, 123 U.S.P.Q. at 352. Because the reversal of the order of the steps described in Shortway, as asserted as obvious by the Examiner, is fundamentally inconsistent with the teachings of Shortway, the rejection over Shortway and McCann is improper and should be withdrawn.

Contrary to the Examiner's position at page 4 of the Office Action, Applicants maintain their position that McCann expressly teaches that chemical embossing is taught as an alternative to mechanical embossing. McCann expressly teaches using either a chemically etching step or mechanically embossing step to provide a surface texture to a cellular foam. Again, these steps are taught in the alternative, not together.

After the vinyl overlay 22 is applied, the web is passed through the fusion and expansion oven 35 and **if chemically etched**, will upon exiting the oven, the cellular foam 17 has the desired textured surface. **However, if optional mechanical embossing is employed** upon exiting the expansion oven, the cellular foam 17 is passed through a

mechanical embosser 40.”) Col. 4, lines 8-15 (emphasis added).

Indeed, the section relied on by the Examiner in the previous Office Action also describes these embossing procedures in the alternative. That is, when McCann begins the discussion on chemical embossing and refers to the Nairn patents, it is clear that it is as an alternative to mechanical embossing, not in combination to mechanical embossing. See, col. 5, lines 14-17 (teaching “*Chemical embossing techniques are alternatives to mechanical embossing*. A chemical embossing technique is described in U.S. Patent No. 2,961,332 issued to R. Frank Nairn.”) col. 5, lines 14-17 (emphasis added). Thus, McCann clearly does not teach the combination of chemical and mechanical embossing, but teaches these as alternative embossing techniques.

Applicants also maintain their position that, with the Applicants’ specification as a guide, the Examiner has plucked individual teachings from different sections of the references to assemble the claimed invention. Accordingly, the combination of Shortway and McCann appears to be based on impermissible hindsight reconstruction.

Moreover, merely identifying all the elements in the prior art is not sufficient to establish a prima facie case of obviousness. See, e.g., *In re Kotzab*, 55 U.S.P.Q.2d 1313 (Fed.

Cir. 2000)(“Most if not all inventions arise from a combination of old elements . . .

identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” (citations omitted)).


For at least these reasons, Applicants submit that the Examiner has not established a *prima facie* case of obviousness, and respectfully request that both rejections under section 103 be withdrawn.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the application and timely allowance of the pending claims. Please grant any necessary extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:  #26,325 for
Louis M. Troilo
Reg. No. 45,284

Date: May 5, 2003

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com